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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,388	02/10/2004	Matthew M. Morrison	4002-3479	9912

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT PAPER NUMBER

3738

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/775,388		MORRISON ET AL.	
	Examiner		Art Unit	
	Bruce E. Snow		3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 and 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21, 23-27, 29, 30 and 32-36 is/are rejected.
- 7) ☒ Claim(s) 22 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/29/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 12/29/05 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

Applicant's arguments filed 2/21/06 have been fully considered. Regarding the rejection of claims 34-36 in view of Yaun et al, the Examiner position is stated in the grounds of rejection below.

Regarding the rejected under 35 U.S.C. 103(a) as being unpatentable over Yuan (US PaW 5616142) in view of Dall (W09801079), applicant's arguments are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in addition to the motivation stated in the rejection, the knowledge generally available to one of ordinary

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skill in the art would easily recognize that the bone fastener configuration Dall designed to fasten a bone plate to bone could be used to fasten the bone elements of Yuan et al to bone wherein the fastener configuration does not require different lengths and there is no longer any need to keep a range of bone screw for a surgeon's use. See at least page 1 of the specification of Dall.

Regarding the rejection under 35 U.S.C. 102(b) as being antipated by Dzus (2,511,051), the hole 32 is "dimpled" (or tapered) which allows for the fastener head to seat flush.

Allowable Subject Matter

Claims 22 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yuan et al (5,616,142).

Yuan et al teaches a medical implant apparatus comprising:

a plate member 10, 10' having a longitudinal axis an upper portion and at least one substantially L-shaped lower portion connected to said upper portion, said upper portion having a substantially flat upper surface, and at least one hole therethrough 12, 12', said lower portion having a flange piece extending substantially parallel to said upper portion, the lower portion extend along **substantially** or at least half the entirety of said length

Regarding claims 35 and 36, a longitudinal axis can be any longitudinal axis including ones which intersect with the hole.

Claims 30, 32, 33 are rejected under 35 U.S.C. 102(b) as being antipated by Dzus (2,511,051).

Dzus discloses a body with a substantially smooth upper surface (Figure 8) with a hole having an axis and at least one tapered section (the opening is "dimpled" which allows for the fastener head to seat flush). The body also has two diametrically opposed fingers (31) and demonstrates a convex lower surface as shown in figure 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yaun et al (5,616,142) in view of Baccelli (6,306,136).

Yuan et al teaches the medical implant as described above, however, is unclear if an intersection of the upper surface and a perpendicular plane yields at least one straight segment. Baccelli, like Yaun et al, teaches an adjustable length medical implant used to connect adjacent vertebrae and teaches the plate member having a flat portion meeting the claim limitation. It would have been obvious to one having ordinary skill in the art to have made the plate 10 of Yaun et al flat which is cheaper and easier to produce and further give the surgeon the choice of which shape best fits the patient.

Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuan (US PaW 5616142) in view of Dall (W09801079).

The majority of Yuan is explained supra, but for the purposes of this rejection Yuan further discloses a plurality of threaded fastening elements (30, column 1, lines 46-49) and a plurality of plate members (figure 2 & column 2, lines 19-22), at least two having different lengths (10' & 20') and a first plate member (10') being substantially straight while a second plate member (20') is not straight as demonstrated by the bump located near hole 22. Yuan also discloses the use of a tool (column 4, lines 12-15) compatible with one of the plate, fastener or nut. However Yuan fails to disclose washers and nuts.

Dall discloses a codical bone fastener with washers (16), nuts (14), and a tool (figure 2b) for securing a plate to bone (claim 15). Dall teaches a variety/ plurality (page 1, lines 4-5) of threaded fasteners (figure 1) with washers (16) being adjacent to the upper surface of the plate member (figure 3) that fit around a fastener adjacently to a nut, and nuts having a portion that extends into the aperture (13) of the plate (11) or washer (16) (page 2- lines 33-37, page 3- lines 1-4) where the nut is usable with a fastener to lock the fastener to the plate (page 1, lines 27-30 & page 3- lines 1-4). One embodiment of Dall's nut shows the washer (16) in combination with the nut and nut housing (figure 5), where the two are rotatable and translatable with respect to each other. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the bone plate fasteners, as taught by Dall with the bone plate of Yuan such that it provides the ability to lock the fasteners to the plate and attach the plate to necessary bony structures.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

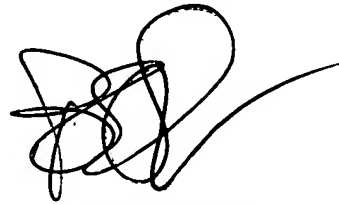
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW
PRIMARY EXAMINER